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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,290	12/28/2001	Kazunori Yoshino	8350.0663-00	3082
22852	7590	06/08/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			LOPEZ, FRANK D	
			ART UNIT	PAPER NUMBER
			3745	

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/029,290	Applicant(s) YOSHINO, KAZUNORI	
	Examiner F. Daniel Lopez	Art Unit 3745	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

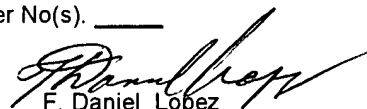
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.


 F. Daniel Lopez
 Primary Examiner
 Art Unit: 3745

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues that the equivalency between Yoshimatsu (5,063,742) and Krusche must be recognized in the prior art, and can not be based on applicant's disclosure or the mere fact that the components are functional or mechanical equivalents; and that the assertion of equivalency is not supported by the rejection (citing MPEP 2144.06).

The last two paragraphs state "The mere fact that phthalocyanine and selenium function as equivalent photoconductors in the claimed environment was not sufficient to establish that one would have been obvious over the other. However, there was evidence that both phthalocyanine and selenium were known photoconductors in the art of electrophotography. "This, in our view, presents strong evidence of obviousness in substituting one for the other in an electrophotographic environment as a photoconductor." 209 USPQ at 759.).

An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. In re Fout, 675 F.2d 297, 213 USPQ 532 (CCPA 1982)".

Yoshimatsu (5,063,742) and Krusche both deal with the art of motor vehicles having hydraulic slewing motors (e.g. 3; 109, respectively) being fed hydraulic fluid from a hydraulic pump (1; e.g. 4, respectively) through a valve (e.g. 2; 111, respectively) pilot operated by pilot fluid from a pilot pump (21; 25, respectively), with an exhaust line (13; 102, respectively) connected through a relief valve (14; unnumbered, e.g. fig 1, respectively) to tank (15; unnumbered, e.g. fig 2, respectively); wherein the pilot pump has a relief valve (23; 230, respectively). Yoshimatsu (5,063,742) teaches the pressure relief valve being connected directly to the tank, and Krusche teaches the pressure relief valve being connected indirectly to the tank, through the relief valve. Since Yoshimatsu (5,063,742) and Krusche are both from the same art (as discussed above), this is evidence that the two ways to connect the pilot relief valve to the tank are known ways, in this art, and therefore, based on MPEP 2144.06, are equivalent. Since the equivalence of these two ways are suggested by the prior art, the substitution is proper.

Applicant argues that the combination of Yoshimatsu (5,063,742) and Yoshimatsu (5,062, 662) is not proper because there is no suggestion or motivation to make the modification, and points to the assertion that they are in the same field of endeavor. Applicant is mistaken. The purpose of making the modification of Yoshimatsu (5,062, 662) is clearly stated in the office action, and supplied by Yoshimatsu (5,062, 662), as unloading the pressure source when not needed.

Applicant argues that the combination of Yoshimatsu (5,063,742) and Yoshimatsu (5,062, 662) is not proper because it changes the principle of operation of Yoshimatsu (5,063,742). Applicant states that the hydraulic control system of Yoshimatsu (5,063,742) is a purely mechanical control system, and draws attention to the main relief valve 12, limiting the pressure to the motor to a preset relief pressure (e.g. page 6 first full paragraph). Applicant states that the hydraulic control system of Yoshimatsu (5,062, 662) is an electronic control system, which includes an electromagnetic selector valve 18 and electromagnetic controller 8 (e.g. paragraph bridging pages 6 and 7). Applicant concludes that since Yoshimatsu (5,063,742) is a purely mechanical control system and when modified by Yoshimatsu (5,062, 662), is converted into an electronic control system, the principle of operation is changed. Furthermore, Applicant concludes that since the MPEP indicates a obvious-type rejection can not change the principle of operation, the combination of Yoshimatsu (5,063,742) and Yoshimatsu (5,062, 662) is not a proper rejection.

The main relief valves (12, 17, respectively) of Yoshimatsu (5,063,742) and Yoshimatsu (5,062, 662) are pilot operated relief valves, which open when a pump pressure (in 11, 10, respectively) exceeds a certain value, to drain fluid from the pump to an exhaust line (13, 71, respectively). Modifying Yoshimatsu (5,063,742) to add a second pilot line, to which a second valve (18) is attached, does not change the principle of operation of the main relief valve, since the main relief valve still opens when a certain value is reached. Rather it only modifies what the certain value is. Since the principle of operation is not changed, the rejection is proper.